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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/663,183	09/15/2000	Christine Dupuis	05725.0753-00000	4212
22852	7590	02/08/2005	EXAMINER	
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			MITCHELL, GREGORY W	
			ART UNIT	PAPER NUMBER
			1617	

DATE MAILED: 02/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/663,183	DUPUIS, CHRISTINE	
	Examiner	Art Unit	
	Gregory W Mitchell	1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33,38-82 and 87-102 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-33,38-82 and 87-102 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This Office Action is in response to the remarks and RCE filed November 12, 2004. Claims 1-33, 38-82, and 87-102 are pending and are examined herein.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on November 14, 2004 has been entered.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-33, 38-82 and 87-102 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blankenburg et al. (WO/99/04750 translation) in view of Firstenberg et al. (USPN 5297566).

Blankenburg et al. teaches the use of polymers containing polysiloxanes for hair cosmetic formulations. A water-dispersible polymer comprising ethylenically

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unsaturated monomers and polyalkylene oxide containing silicone derivatives is taught. The silicone derivatives of formula (I) of the instant invention is taught, as is its R1, R2, R3, and R5 constituents. Dimethicone copolyols and silicone surfactants are taught as preferred compounds of formula I. The ethylenically unsaturated monomer of formula Ia of the instant invention is also taught, as is its X, R7 and R6 constituents, as are ethylenically unsaturated monomers further comprising silicone atoms, fluorine atoms, and thio groups, which meets claims 18 and 67. The silicone/acrylate copolymers are soluble in proportion of greater than 0.1g/l, and preferably more than 0.2g/l in a water/ethanol mixture, which meets claims 30, 31, and 79-80. Cosmetic additives are taught to include fragrances, preserving agents, vitamins, proteins, and others, which meets claims 48 and 97. A process of making and using the cosmetic product is taught. Specifically, taught are hair cosmetic preparations, such as hairsprays. The instant polymers are taught as strengthening hairdos and providing a desired property profile for hair fixatives without imparting an unpleasantly dull and unnatural feel. Blankenburg et al. also teaches that vinyl lactam homo and copolymers have been successfully used for setting hairstyles. The reference lacks polyvinylpyrrolidone/vinyl acetate/vinyl propionate terpolymers, preferred cosmetic mediums, and preferred percent weight. See entire disclosure.

Firstenberg et al. teaches an aerosol device comprising a container containing an aerosol composition, comprising a liquid phase containing *at least one* film-forming polymer in a solvent and a gas phase (col. 1, lines 44-62; Examples 1-16).

Vinylpyrrolidone/vinyl acetate/vinyl propionate copolymer is taught and exemplified as a

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film forming and hair setting polymer useful in the invention disclosed by Firstenberg et al. (col. 2, lines 41-56; Example 9). The hair setting polymers are taught to comprise between 1 and 6 percent of the liquid phase (col. 2, lines 41-43). The compositions of Firstenberg et al. are taught to optionally comprise polyols, softening agents, perfumes, proteins, vitamins, etc. (col. 2, line 57-col. 3, line 8). Ethanol, isopropanol, water, etc. and their mixtures are taught as solvents useful in the invention taught therein (col. 2, lines 28-40). Mixtures of ethanol and water are exemplified as solvents (Examples 1 and 3).

It would have been obvious to one of ordinary skill in the art at the time of the invention to add the vinylpyrrolidone/vinyl acetate/vinyl propionate copolymer of Firstenberg et al. to the hair fixative composition of Blankenburg et al. because (1) Blankenburg and Firstenberg et al. both teach hair care fixative compositions in the form of sprays; (2) Firstenberg et al. teaches vinylpyrrolidone/vinyl acetate/vinyl propionate copolymers as film forming polymers useful for setting hair; (3) Blankenburg et al. teaches that vinyl lactam homo and copolymers are known in the art as synthetic polymers that have been used for almost 50 years to strengthen hairdos; (4) Blankenburg et al. teaches that other cosmetic agents can be added to his composition; and (5) Firstenberg et al. teaches that more than one hair setting polymer may be used in a hair setting composition. One would have been motivated to add the hair setting polymer vinylpyrrolidone/vinyl acetate/vinyl propionate copolymer of Firstenberg et al. to the composition of Blankenburg et al. because of an expectation of similar success in preparing a hair setting composition. It is obvious to combine two

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compositions taught by the prior art to be individually useful for the same purpose to form a third composition to be used for that very same purpose. *In re Kerkhoven*, 205 USPQ 1069 (CCPA 1980).

It would have been obvious to one of ordinary skill in the art at the time of the invention to teach the vinylpyrrolidone/vinyl acetate/vinyl propionate copolymers as comprising 0.2-5% of the silicone acrylate copolymers; to have taught the silicone acrylate copolymers as comprising 0.1-20% of the composition; and to have taught the vinylpyrrolidone/vinyl acetate/vinyl propionate copolymers of the molecular weight claimed herein because it has been held that where the general conditions of a claim are disclosed in the prior art, discovering optimum or workable ranges involves only routine skill in the art, *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955), and because Firstenberg et al. teaches fixatives as comprising 1-6% of the liquid phase of a hair fixing composition.

It is further respectfully pointed out that while it is not explicitly stated in Blankenburg et al., hair sprays, such as those taught by Blankenburg et al. are applied to the hair. It is also noted that Firstenberg et al. discloses a method of administering the setting compositions disclosed there to the hair.

Response to Arguments

Applicant's arguments with regard to the status of Saiman et al. (USPN 6511651) as not applicable under 35 USC 103(c) because of common ownership is persuasive. The rejections of the previous Office Action as pertaining thereto are hereby withdrawn.

Applicant's arguments as they apply to the instant rejection are addressed as applicable.

Applicant argues that "[i]n order to establish a prima facie case of obviousness, the Examiner must, among other things, point to a suggestion or motivation within the references to modify or combine the reference teachings." This argument is not persuasive because, as stated herein, the motivation to combine the references is an expectation of success in preparing a hair setting composition as taught by both Blankenburg et al. and Firstenberg et al.

Applicant argues "It is not enough that references can be combined or modified – this 'does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.'" This argument is not persuasive. "It is *prima facie* obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose... [T]he idea of combining them flows logically from their having been individually taught in the prior art." MPEP 2144.06 (citing *In re Kerkhoven*, 626 F.2d 846, 850, 205 USPQ 1069, 1072 (CCPA 1980)).

Applicant further argues, "even when combining the various components of the claimed composition may have been obvious to try, it does not constitute the standard for combining references under section 103." This argument is not persuasive because the prior art references cited herein specifically teach and exemplify hair setting compositions that when combined render the instant claims obvious. See *In re Kerkhoven*, 626 F.2d 846, 850, 205 USPQ 1069, 1072 (CCPA 1980).

Applicant argues, "In its discussion of the prior art uses of synthetic polymers for hairstyling, Blankenburg states that '[a]t first, vinyl lactam homopolymers and copolymers were preferred, but subsequently polymers containing carboxylate groups have become increasingly important.'" Applicant continues, "Such a statement at the very beginning of Blankenburg's disclosure indicates that the invention of Blankenburg is a departure from, and alternative to, vinyl lactam copolymers." These arguments are not persuasive. Simply because Blankenburg et al. states that polymers containing carboxylate groups have become increasingly important does not mean that Blankenburg et al. is teaching that vinyl lactam polymers have become obsolete or even less important.

Applicant argues "the fact that Blankenburg may teach that other cosmetic agents can be added to the composition, point [(4)], does not constitute a suggestion to modify Blankenburg with the addition of vinyl lactams." This argument is not persuasive for the reason stated above that it is obvious to combine compositions individually known for the same purpose. It is further noted that Firstenberg et al. teaches that *at least one* film forming polymer be used in a hair setting composition. Accordingly, it is within the skill of the art to utilize more than a single hair setting polymer in a hair setting composition.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was

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within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

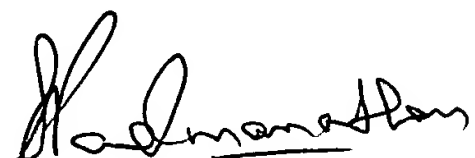
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory W Mitchell whose telephone number is 571-272-2907. The examiner can normally be reached on M-F, 8:30 AM - 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

gwm



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SUPERVISORY PATENT EXAMINER**